

Applicants hereby provisionally elect, with traverse, to prosecute the invention of Group I, Claims 1-8, 11-17, and 48, drawn to an assay for identifying inhibitors of influenza virus nucleoprotein-host cell protein binding interactions. Applicants note that Claims 4-10 were withdrawn from consideration as being drawn to non-elected species (*see*, Provisional Election, filed on January 13, 1997 and the Office Action, dated March 27, 1999). Thus, Group I should consist of Claims 1-3, 11-17 and 48.

Applicants respectfully request that the Examiner withdraw the requirement for restriction so that the claims are all examined together. At the very least, Applicants respectfully request that the requirement for restriction be modified so that only a species election is required, in which case, Applicants provisionally elect, with traverse, the species of Group I, as set forth in the Restriction Requirement.

The claims in Groups I-XII are all drawn to assays for identifying compounds that inhibit viral protein-host cell protein interactions. Moreover, it is noted that the Examiner has cited M.P.E.P. 806.04 and 808.01 as a basis for the restriction requirement. Applicants respectfully submit that these sections, in contrast to the Examiner's contention, support the examination of all the pending claims in the instant application.

Section 806.04 of the M.P.E.P. relates to "Independent Inventions." However, the Examiner has not shown how any of the provisions of this section demonstrate that the groups identified by the Examiner are indeed independent inventions. To the contrary, subsection 806.04(d) clearly indicates that Claim 1 of the instant application is a proper generic claim. In particular, this subsection states:

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must

comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claims.

M.P.E.P. § 806.04(d). Claim 1 of the instant application clearly meets this standard for a proper generic claim encompassing the species of its dependent claims.

Reconsideration of the Restriction Requirement is also supported by § 808.01 of the M.P.E.P., cited by the Examiner. In particular, this section states:

Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP § 806.04), *the facts relied on for this conclusion are in essence the reasons for insisting upon restriction. This situation, except for species, is but rarely presented*, since persons will seldom file an application containing disclosures of independent things.

M.P.E.P. § 806.04 (italicized emphasis in original, underlined emphasis added). Indeed, the instant application does not contain disclosures to "independent things," but rather discloses, *inter alia*, novel assay systems for inhibitors of viral-host cell protein interactions that apply to a variety of different proteins. Applicants respectfully submit, as clearly suggested by the passage from § 806.04 quoted above, that at most, the groups identified by the Examiner are species of the invention set forth in claim 1.

In fact, a restriction requirement as well as a species election has already been required by the U.S. Patent and Trademark Office, and made by the Applicants, in connection with the prosecution of the instant application (*see*, Office Action, dated September 13, 1996). Indeed, Group I in the present Restriction Requirement corresponds to the Group I, species A election made by the Applicants in their response to the first Restriction

Requirement (*see*, Provisional Election, filed on January 13, 1997). Thus, the entire scope of Claim I has already been under active consideration, including searches by the Examiner and responses by the Applicants, in connection with the prosecution of the instant application.

In order for a requirement for restriction to be proper, M.P.E.P. § 803 states that there "must be a serious burden on the examiner" in the absence of the requirement (emphasis added). Thus, in view of M.P.E.P. § 803, all of the subject matter in Groups I-XII should be examined together, especially if any rejections specific to the subject matter of Group I are overcome. Even if the subject matter of these groups are distinct inventions, as asserted by the Examiner, it would not be a "serious burden" on the Examiner to search these groups in this application.

In summary, Applicants have demonstrated that the subject matter of the claims of Groups I-XII should be examined in the same application. Applicants request, therefore, that the restriction requirement be withdrawn, or, at the very least, modified such that only a species election is required.

Applicants reserve the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Respectfully submitted,

*by Jacqueline B. ...*  
*Reg. No. 143,112*

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Laura A. Coruzzi *SS* 30,742  
(Reg. No.)

**PENNIE & EDMONDS LLP**  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090